This application has been reviewed in light of the Office Action dated October 16, 2006. Claims 1-23 are presented for examination, and have been amended to define more clearly what Applicant regards as his invention. Claims 1, 12, and 23 are in independent form. Favorable reconsideration is requested.

Claims 1, 2, 4-6, 9-13, 15-17 and 20-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 7,089,286 (Malik). In addition, Claims 3, 8, 14, and 19 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent 7,089,286 (Malik) in view of U.S. Patent 6,868,183 (Kodaira), and Claims 7 and 18, as being obvious from *Malik* in view of U.S. Patent 6,157,389 (*Knowlton*).

Applicant submits that independent Claims 1, 12 and 23, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

Initially, Applicant notes that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. MPEP §2131 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant submits that *Malik* does not anticipate Claim 1 because at least one element of Claim 1 is not found expressly or inherently in *Malik*.

The aspect of the present invention set forth in Claim 1 is a communication apparatus comprising connecting means for connecting the communication apparatus to a communication network containing an electronic mail exchange device. Input means are

provided for inputting image data representing an image, and transmitting means transmit an electronic mail, to which the image data inputted by the input means is attached, via the connecting means. Receiving means are provided for receiving an electronic mail as notification of an error, via the connecting means, and analyzing means analyze such electronic mail. Converting means are provided for converting the size of the image data into a smaller size according to an analysis result obtained by the analyzing means, and control means in such a case automatically carry out a controlling operation to retransmit the electronic mail, with the reduced-size image data attached, by the transmitting means, in response to the receiving means receiving such electronic mail notifying that the size of the earlier electronic mail transmitted by the transmitting means is too large. Also provided are output means that output a report including at least a transmitting date, a destination and information for specifying a conversion method used by the converting means, in a case where the retransmitting of the electronic mail by the transmitting means has been carried out.

Among other notable features of Claim 1 are the output means for outputting a report including at least a transmitting date, a destination and information for specifying a conversion method used by said converting means, in a case where the electronic mail has been retransmitted by the transmitting means. This feature makes it possible for the user to recognize when, to where, and how the image data is retransmitted with its size reduced. An example of this feature is when the printer 2095 prints out the transmission report, as shown in FIGS. 36 and 37.[1]

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[1] It is of course to be understood that the claim scope is not limited by the details of this or any other particular embodiment that may be referred to.

Malik relates to a system for compressing e-mail attachments for transmission, in which a table stores a compressibility factor for each of various types of files, indicating by what percentage a file of a given type can be compressed. Each attachment of a type whose stored compressibility factor is above a certain value, is compressed. Alternatively, an attachment-configuration module compresses a number of attachment files according to the size of each and the corresponding compressibility factor, in such manner as to maximize the total size of the e-mail communication (after compression) while keeping that total size below a threshold value.

In one embodiment, *Malik* analyzes an "undeliverable" message received from an e-mail destination to determine what the size limit for e-mail attachments is on the recipient's LAN, and automatically reconfigures and re-sends the undelivered message in such manner as to meet the limitations of the recipient's LAN (col. 7, line 60, through col. 8, line 17). Nonetheless, nothing has been found in *Malik* that is believed to teach or suggest means for outputting a report including at least a transmitting date, a destination and information for specifying a conversion method in a case where retransmission of an e-mail has been performed in response to receipt of an error message, as recited in Claim 1. Moreover, nothing has been found in *Malik* that would teach or suggest recognizing by what converting method the size is converted after the retransmitting has been carried out, and thus, even if that patent did contain some suggestion for outputting a report after retransmission, it would not be possible for such report to identify the reconversion method, as is done in an apparatus constructed according to Claim 1.

Accordingly, Applicant submits that Claim 1 is not anticipated by , nor obvious

from, *Malik*, and respectfully requests withdrawal of the rejection of that claim. Independent Claims 12 and 23 include features similar to those discussed above with respect to Claim 1, and those claims also are believed to be patentable for at least the reasons discussed above.

The other claims in this application are each dependent from one or the other of Claims 1 and 12, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and an early issuance of a Notice of Allowance.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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